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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,666	08/30/2001	Hirofaka Yamamoto	011063	9199
38834	7590	05/05/2004		
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
			EXAMINER SHEWAREGED, BETELHEM	
			ART UNIT 1774	PAPER NUMBER

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,666

Applicant(s)

YAMAMOTO, HIROTAKA

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response along with Request for Continued Examination (RCE) filed on 04/19/2004 has been fully considered. Claim 1 is canceled, claim 20 is amended, and thus claims 2-20 are pending. (NOTE: Claims 6-19 are withdrawn as non-elected invention).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-5 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Igarashi et al. (US 5,882,755).

Igarashi discloses an ink jet recording sheet having a support and at least one ink receiving layer, wherein a cationic polymer is impregnated in at least one of the support and the ink receiving layer (abstract). Polycondensate of dicyandiamide is a suitable example of the impregnated cationic polymer (col. 12, line 7). The ink receiving layer further contains at least one or a combination of porous silica, aluminum silicate and pseudoboehmite as a pigment (col. 12, line 14). The aluminum silicate is equivalent to the claimed aluminum salt, and the pseudoboehmite is equivalent to the claimed hydrate aluminum oxide. The ink receiving layer also contains a binder such as silyl-modified polyvinyl alcohol (col. 13, line 9). The amount of the pigment falls within

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the claimed range, i.e., in one embodiment the calculated amount of the pigment in the ink receiving layer is 75% (Ink receiving layer A in col. 17, line 65 thru col. 18, line 8).

With respect to the pH value it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Igarashi reference teaches all of Applicant's claimed compositional and positional limitations, i.e., ink jet recording sheet having a support, an ink receiving layer on the support and impregnated cationic polymer in the support and/or in the ink receiving layer, wherein the ink receiving layer comprises a pigment and a binder as the claimed invention, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

Igarashi does not disclose the claimed amount of the cationic polymer. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the amount of the cationic polymer in order to optimize the water resistance and ink fixing properties of the layer (col. 7, lines 18-38). A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Response to Arguments

4. Applicant's argument is based on that there is no specific disclosure to impregnate the cationic polymer in the ink receiving layer. This argument is not persuasive because it is disclosed at least in the abstract, on col. 3, line 39 and on col. 7, line 23.

Applicant also argues that the examples do not specifically disclose any impregnation of the cationic polymer in the ink receiving layers. This argument is not persuasive because the invention of the prior art is not limited to the examples only.

Applicant further argues that the claimed amount of the cationic polymer impregnated in the ink receiving layer is not disclosed in the prior art. This argument is not persuasive for the following reason. The examiner showed in the previous Office Action that the amount of the cationic polymer is optimizable because the current specification does not show the criticality of such limitation.

For the above reasons claims 2-5 and 20 stand rejected.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Betelhem Shewareged
May 1, 2004.